

REMARKS

Claims 1, 4, 7, 8, 10, 12, 13, 15, 16, 18-21, 26, 27, 29, 31, 33, 34, 37, 40, 42, 43, 45-49 and 51-58 have been amended. Claims 3, 17, 25, 36 and 50 were earlier cancelled. No new claims have been added. Claims 1, 2, 4-16, 18-24, 26-35, 37-49 and 51-58 are pending.

Claim Rejections - 35 USC § 103

The Examiner rejected claims 1, 2, 4, 6, 10-12, 15, 16, 31, 32, 37, 39, 40-42, 45, 46, 51 and 53-56 under 35 USC § 103(a) as obvious from Marmigere *et al.* (US Pub. 20040068579) in view of Kausik *et al.* (US 7,159,014) and Bond *et al.* (US 7,251,254). This rejection is respectfully traversed.

I. The Cited References Do Not Disclose the Claimed Limitations

The claims have been amended to recite that the actions are performed by a network access provider server. None of the cited references disclose a network access provider server that performs the totality of the claimed limitations. The claims have been amended to recite that the requester is a web browser at a client computer. As such, the claims recite actions performed by the network access provider server with the client computer and other client computers. None of the cited references disclose a network access provider server that performs the claimed actions with the client computer and other client computers.

II. Arguments from Earlier Office Actions

A. Motivation to Combine

The Examiner correctly states that the “Supreme Court in KSR noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit”. However, the Examiner then baldly states that the motivation to combine Marmigere, Kausik and Bond is “to inform a user that certain request can not be carried out, e.g. forbidden webpages”. (Office Action, p. 4, lines 13-15 and p. 14, lines 10-12) No explicit description of the motivation is provided. That is, it is unclear why any of the systems Marmigere, Kausik and Bond inform users about hidden web pages.

Importantly, in the Response filed 1/12/2009, we stated that the claims do not recite informing a user that a request cannot be carried out. We again assert that there can be no motivation to combine to achieve a goal which the claims do not achieve.

We maintain our assertion that motivation stated by the Examiner is wholly irrelevant and inapplicable to the claims. The claims (and the entire patent application) have nothing whatsoever to do with informing a user that a request cannot be carried out. As such, the Examiner has not provided a sufficient motivation to combine. Therefore, the Examiner fails to make a *prima facie* case of obviousness.

As such, we assert that the claims are in condition for allowance.

The Final Office Action and Advisory Action do not address the following two paragraphs which were include in the Responses filed 1/12/2009 and 6/9/2009. We respectfully request that the Examiner consider the following two paragraphs and address the remarks made therein.

The Examiner has apparently misunderstood the claims. When the motivation to combine provided by the Examiner on p. 4 of the Office Action is viewed in comparison with the content of the independent claims, it can only be concluded that the Examiner has misunderstood the claims. That the Examiner asserts that the motivation to combine Marmigere, Kausik and Bond is “to inform a user that certain request can not be carried out” shows that the Examiner does not understand the claims. (Final Office Action, p. 4, lines 13-15) Simply, the claims do not recite “inform[ing] a user that certain request can not be carried out”. To the contrary and quite differently, all of the claims recite, in pertinent part, providing an amended response to other requesters. There is no mention of informing a user that a request cannot be carried out in any of the claims.

All of the independent claims recite a requester from which a request is received and a server from which a response is received. Claims 1, 15, 31 and 45 are independent. Specifically, according to claim 1, in part, when the response does not include a native expiration, an amended response including a computed expiration is provided to other requesters, namely web browsers. According to

claim 15, in part, when the response does not include a native expiration, an amended response including a calculated expiration is provided to the requester and to other requesters, namely web browsers. According to claims 31 and 45, in part, when the response does not include a native expiration, an amended response including a computed expiration is provided to the requester and to other requesters, namely web browsers. Based on the content of the independent claims, the motivation to combine provided by the Examiner on p. 4 of the Office Action is wholly inapplicable.

B. Incorrect Statement of the Rejection of Claims 1, 2, 4, 6, 10-12, 31, 32, 37, 39, 40-42, 45, 46, 51 and 53-56

The Examiner states that neither Marmigere nor Kausik teach forwarding the response to the requester when the status code is not actionable. The Examiner asserts that Bond teaches forwarding the response to the requester when the status code is not actionable. ***However, independent claims 1, 31 and 45 do not recite a status code limitation.*** This limitation is only included in independent claim 15. As such, the obviousness rejection of claims 1, 2, 4, 6, 10-12, 31, 32, 37, 39, 40-42, 45, 46, 51 and 53-56 is apparently being made using the combination of Marmigere and Kausik only. We reiterate our request that the Examiner make an applicable case of obviousness for these claims.

C. Bond Does Not Teach What It Is Cited For – Claim 15

Apparently referring to independent claim 15, the Examiner states that neither Marmigere nor Kausik teach forwarding the response to the requester when the status code is not actionable. We ask that the Examiner clarify to which claim or claims this specific argument applies.

The Examiner asserts that Bond teaches forwarding the response to the requester when the status code is not actionable. The Examiner cites col. 5, lines 15-64 of Bond. However, the cited portion of Bond teaches a list of status codes used in a particular embodiment of a voice over Internet protocol (VOIP) system that uses the session initiation protocol (SIP). Another portion of Bond merely teaches setting up and tearing down SIP connections based on messages or codes. (Bond, 11:41-53. While we agree that Bond teaches SIP status codes, the context of the use of status codes

in view of the teachings of the Bond VOIP system must be considered to evaluate the applicability of the teaching to the claims of this matter.

Review of Bond shows that there is nothing in Bond that teaches “when the status code is not actionable, forwarding the response to the requester” as claimed. Bond is limited to teaching SUP call setup and teardown. Nothing more.

As none of the cited references disclose “when the status code is not actionable, forwarding the response to the requester”, claim 15 and all claims depending thereon are patentable over the cited combination of references.

In the Final Office Action, the Examiner asserts that checking to see whether an expiration date is exhausted inherently checks/determines whether the expiration is present. This argument apparently applies to those claims with a native expiration limitation. Not to claim 15, but to claims 1, 15, 31 and 45.

Specifically, according to claim 1, in part, when the response does not include a native expiration, an amended response including a computed expiration is provided to other requesters. According to claim 15, in part, when the response does not include a native expiration, an amended response including a calculated expiration is provided to the requester and to other requesters. According to claims 31 and 45, in part, when the response does not include a native expiration, an amended response including a computed expiration is provided to the requester and to other requesters.

We disagree that checking to see whether an expiration date is exhausted inherently checks/determines whether the expiration is present in the context of the claims. What Marmigere and Kausik teach is that certain actions are taken with requests that have an expiry date. What the claims recite is very different. The claims recite checking whether a response includes a native expiration, and when the response does not include the native expiration, taking certain actions.

What is claimed on the one hand and what is disclosed in Kausik and Marmigere on the other are very different constructs.

Checking whether a response includes a native expiration is wholly different from checking the value of a native expiration in a response. This is made clear by the follow-on actions, namely adding a native expiration or amending/changing an expiration. The results are wholly different. Therefore, claims 1, 15, 31 and 45 and all claims depending thereon are patentable over the cited references.

D. Marmigere Does Not Teach What It Is Cited For

The Examiner asserts that Marmigere teaches “reviewing the response to determine whether the response includes a native expiration” as recited in claims 1, 15, 31 and 45, and teaches “evaluating whether the response has a status code that is actionable” as recited in claim 15. However, Marmigere does not teach these limitations.

As to the “reviewing the response to determine whether the response includes a native expiration” limitation as recited in claims 1, 15, 31 and 45, the Examiner directs us to paras. 47 and 49 of Marmigere. However these paragraphs of Marmigere do not teach “reviewing the response to determine whether the response includes a native expiration”. The cited paragraphs of Marmigere disclose in para. 47 that “The Proxy cache server processes the request and finds the object in its cache but the expiration date is exhausted.” That is, Marmigere does not check to see whether a native expiration exists, rather, Marmigere teaches that the expiration date is checked to learn whether it is exhausted. Checking whether an expiration date is exhausted is wholly different from checking whether an expiration date is present. Marmigere does not teach “reviewing the response to determine whether the response includes a native expiration” limitation as recited in claims 1, 15, 31 and 45. Bond and Kausik likewise do not teach this limitation. Because the combination of references fails to teach “reviewing the response to determine whether the response includes a native expiration”, claims 1, 15, 31 and 45, and all claims depending thereon are patentable over the combination of cited references.

Further, the Examiner asserts that “computing a computed expiration for the response” and “inserting the computed expiration into the response creating an amended response” “when the response does not include the native expiration” as recited in claims 1, 15, 31 and 45 are taught in paras. 47 and 49 of Marmigere. However, the only thing at all related to these limitations is updating an existing expiration date for an already stored object when a code 304 is received specifying that the object on the server has not been modified. (Marmigere para. 49) However, this does not teach “computing a computed expiration for the response” and “inserting the computed expiration into the response creating an amended response” “when the response does not include the native expiration” as recited in claims 1, 31 and 45. Bond and Kausik likewise do not teach this limitation. As claim 15 includes the same limitation substituting the term “calculate” for “compute”, the same arguments apply to claim 15. Because the combination of references fails to teach “computing a computed expiration for the response” and “inserting the computed expiration into the response creating an amended response” “when the response does not include the native expiration”, claims 1, 15, 31 and 45, and all claims depending thereon, are patentable over the combination of cited references.

In addition, the Examiner asserts that “forwarding the amended response to the requester, wherein the amended response includes the requested object” and/or “providing the amended response to other requesters that request the requested object, the providing achieved without additional communication with the server” as recited in claims 1, 15, 31 and 45 is taught in paras. 47 and 49 of Marmigere. However, there is nothing like this taught in Marmigere. Marmigere teaches that information about the object is stored on the server, and that the object is provided to the client. Specifically, Marmigere states that “the Proxy cache server sends back to the client device the object it had already stored in its auxiliary memory and updates the expiration date corresponding to this object in its Cache_index_table”. As such, Marmigere fails to teach “forwarding the amended response to the requester, wherein the amended response includes the requested object” and/or “providing the amended response to other requesters that request the requested object, the providing achieved without additional communication with the server” as recited in claims 1, 15, 31 and 45. Bond and Kausik likewise do not teach this limitation. Because the combination of references fails

to teach “forwarding the amended response to the requester, wherein the amended response includes the requested object” and/or “providing the amended response to other requesters that request the requested object, the providing achieved without additional communication with the server”, claims 1, 15, 31 and 45, and all claims depending thereon, are patentable over the combination of cited references.

E. Kausik Does Not Teach What It Is Cited For

The Examiner states that Marmigere does not explicitly teach when the response does not include the native expiration calculating a calculated expiration for the response. The Examiner asserts that “if Marmigere’s system checks to see if an expiration date is exhausted then it inherently checks/determines whether an expiration date is present”. (P. 4 of the Advisory Action) This is not so. The protocol or system in Marmigere may require that an expiration date be present. Or the Marmigere system may not do anything if an expiration date is missing. If so, Marmigere teaches away from the claims which recite specific actions “when the response does not include the native expiration”, namely “computing a computed expiration for the response”, “inserting the computed expiration into the response creating an amended response”, “forwarding the amended response to the requester, wherein the amended response includes the requested object”, “storing the amended response” and “providing the amended response to other requesters at other client computers that request the requested object, the providing achieved without additional communication with the server”.

The Examiner asserts that this is taught by Kausik at col. 5, lines 17-30. This portion of Kausik teaches that “For each embedded object in the Web document: ... creat[ing] a modified header for the object comprising: an expiry date sufficiently far in the future”. Kausik 5:13-17. Unlike what is claimed, Kausik teaches that a modified header comprising an expiry date is prepared without regard to whether there is a native expiration associated with the object or not. As such, this portion of Kausik does not teach or suggest “when the response does not include the native expiration”, “computing a computed expiration for the response” as recited in claims 1, 31 and 45;

and “when the response does not include the native expiration”, “calculating a calculated expiration for the response” as recited in claim 15.

Moreover, any teachings in Kausik relating to a last-modified date are not pertinent to the “native expiration” limitation. This is because a last-modified date is wholly different from a “native expiration”. Neither Bond nor Marmigere teach these limitations. As such, the combination of references fails to teach all of the claimed limitations. Therefore, claims 1, 15, 31 and 45, and all claims depending thereon, are patentable over the cited references.

F. Claims 5, 7-9, 33-35, 38, 47-49 and 52

The Examiner rejected claims 5, 7-9, 33-35, 38, 47-49 and 52 under 35 USC § 103(a) as obvious from Marmigere in view of Kausik, Bond, and Choquier *et al.* (US 5,768,515). This rejection is respectfully traversed. As these claims depend on independent claims 1, 31 and 45, these claims are patentable for the reasons set forth above regarding claims 1, 31 and 45. Choquier does not cure the deficiencies of Marmigere, Kausik, and Bond set forth above. Therefore, claims 5, 7-9, 33-35, 38, 47-49 and 52 and all claims depending thereon, are patentable over the cited references.

G. Claims 13, 14, 43, 44, 57 and 58

The Examiner rejected claims 13, 14, 43, 44, 57 and 58 under 35 USC § 103(a) as obvious from Marmigere in view of Kausik, Bond, and Office Notice. This rejection is respectfully traversed. As these claims depend on independent claims 1, 31 and 45, these claims are patentable for the reasons set forth above regarding claims 1, 31 and 45. Neither Bond nor Office Notice cure the deficiencies of Marmigere and Kausik set forth above. Therefore, claims 13, 14, 43, 44, 57 and 58, and all claims depending thereon, are patentable over the cited references.

H. Claims 18-24 and 26-28

The Examiner rejected claims 18-24 and 26-28 under 35 USC § 103(a) as obvious from Marmigere in view of Kausik and Choquier. This rejection is respectfully traversed. As these claims depend on independent claims 15, these claims are patentable for the reasons set forth above

regarding claim 15. Choquier does not cure the deficiencies of Marmigere and Kausik set forth above. Therefore, claims 18-24 and 26-28, and all claims depending thereon, are patentable over the cited references.

Disclaimers Relating to Claim Interpretation and Prosecution History Estoppel

Any reference herein to “the invention” is intended to refer to the specific claim or claims being addressed herein. The claims of this application are intended to stand on their own and are not to be read in light of the prosecution history of any related or unrelated patent or patent application. Furthermore, no arguments in any prosecution history relate to any claim in this application, except for arguments specifically directed to the claim.

Conclusion

It is submitted that the independent and dependent claims include other significant and substantial recitations which are not disclosed in the cited references. Thus, the claims are also patentable for additional reasons. However, for economy the additional grounds for patentability are not set forth here.

In view of all of the above, it is respectfully submitted that the present application is now in condition for allowance. Reconsideration and reexamination are respectfully requested and allowance at an early date is solicited.

The Examiner is invited to call the undersigned registered practitioner to answer any questions or to discuss steps necessary for placing the application in condition for allowance.

Respectfully submitted,



Mark Andrew Goldstein
Reg. No. 50,759

Date: July 9, 2009

SoCal IP Law Group LLP
310 N. Westlake Blvd., Suite 120
Westlake Village, CA 91362
Telephone: 805/230-1350 x240
Facsimile: 805/230-1355
Email: mgoldstein@socalip.com